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APPLICATION NO. 05/987,468	FILING DATE 12/10/97	FIRST NAMED INVENTOR GERS-BARLAG	ATTORNEY DOCKET NO. H
SPRUNG KRAMER SCHAEFER & BRISCOE 660 WHITE PLAINS ROAD 4TH FLOOR TARRYTOWN NY 10591-5144			BEIERSDORF
HM42/1106			EXAMINER LAMM, M
ART UNIT 1616		PAPER NUMBER	
DATE MAILED: 11/06/98			

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1-File

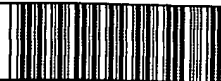
# Office Action Summary

Application No.  
**08/987,468**

Applicant(s)  
**Gers-Barlag et al.**

Examiner  
**Marina Lamm**

Group Art Unit  
**1616**



- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1, 2, and 4-11 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 2, and 4-11 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Claims 1, 2 and 4-11 are pending in this application filed 12/09/97 based on German application No. 196 51 478.9 filed 12/11/96.

Applicants' claims are drawn to a sunscreen composition containing one or more UV filter substances and one or more surface-active mono-or oligoglyceryl compounds.

#### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in 37 CFR 1.56.

#### ***Claim Objections***

2. Claims 1, 4 and 8 are objected to because of the following informalities: use of bullets. Appropriate correction is required.

#### ***Double Patenting***

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3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1,2 and 4-11 are rejected under the judicially created doctrine of double patenting over claims 1-14 of U. S. Patent No. 5,725,844 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both inventions teach sunscreen cosmetic compositions in the form of emulsions, comprising one or more organic UV filter compounds containing one or more sulphonic acid groups; one or more hydrophobic inorganic pigments incorporated into the oily phase of the emulsion; mono- or oligoglyceryl compounds; and other conventional cosmetic additives. Both inventions also teach a method for achieving or increasing the water resistance of sunscreen formulations by incorporating the hydrophobic inorganic pigments into the oily phase of the emulsion.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2 and 4-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2 and 4-11 use improper Markush claim language: "selected from the group of" or "selected from". Proper Markush claim language is : "selected from the group consisting of".

Claims 1, 4 and 8 are viewed as indefinite because they contain alternative language "and/or" within Markush claim language.

Claims 1, 4 and 8 are rendered indefinite by the phrase "although in this case". The following changes in the claim language would be suggested: "R1, R2 and R3, independently of one another, are selected from the group consisting of H, branched or unbranched, saturated or unsaturated alkyl radicals, branched or unbranched, saturated or unsaturated acyl radicals, with the proviso that at least one of the radicals R1, R2 and R3 is not H..."

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2, 5, 7, 9 and 11 recite the broad recitation "inorganic pigments" (Claim 2), "R1, R2 and R3 are selected from" (Claims 5 and 9), "are present in concentrations of from 0.005 to 50% by weight" (Claims 7 and 11), and the claims also recite "which have *preferably* been superficially hydrophobed" (Claim 2), "the isostearyl radical being *preferred*" (Claims 5 and 9) and "*preferably* in concentrations of from 0.5 to 10% by weight, *in particular* from 1.0 to 5% by weight" which are the narrower statements of the range/limitations. Please note, for the purpose of examination, the phrase "which have *preferably* been superficially hydrophobed" in Claim 2 is interpreted as "which have *optionally* been superficially hydrophobed".

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Claims 5-7 and 9-11 are rendered indefinite by the phrase "characterized in that" because it is not readily apparent what the applicant intends by said phrase. The examiner of record suggests the use of phrase "wherein" as an alternative.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Grollier et al. (US 5,427,771).

Grollier et al. teach a cosmetic composition that contains the claimed combination of UV screening agents having one or more sulphonic acid groups (col. 3, lines 49-50, 54-55 and 60), from 4 to 35% of emulsifiers, including mono- and diesters of fatty acids (C12-C18) and glycerol or polyglycerol (col. 5, lines 27-39), and titanium dioxide flakes (col. 2, lines 34-36).

Thus, Grollier et al. teach each and every limitation of Claims 1, 2 and 5-7.

9. Claims 1, 2, 4, 5, 7-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Gers-Barlag et al. (US 5,725,844).

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Gers-Barlag et al. teach a cosmetic composition in the form of O/W emulsion comprising one or more cosmetically acceptable oil- or water-soluble organic UV filter substances, including salts of 2-phenylbenzimidazole-5-sulphonic acid, sulphonic acid derivatives of benzophenones, sulphonic acid derivatives of 3-benzylidenecamphor (col. 7, lines 55-65); one or more cosmetically acceptable hydrophobic inorganic pigments, these pigments being incorporated into the oily phase of the emulsion (col. 3, lines 48-50; col. 5, lines 9-45), emulsifiers, including glyceryl stearate and glyceryl lanolate (Examples 1-4); and other cosmetically acceptable compounds.

Gers-Barlag et al. also teach a method for achieving or increasing the water resistance of sunscreen formulations by incorporating the hydrophobic inorganic pigments into the oily phase of the emulsion. See col.4, lines 16-26.

Gers-Barlag et al. employs glyceryl stearate in concentration of 3wt% which is within the claimed range. See Examples 1 and 2

Thus, Gers-Barlag et al. teach each and every limitation of Claims 1, 2, 4, 5, 7-9 and 11.

10. Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Billia et al. (US 5,486,353).

Billia et al. teach sun protection creams (W/O or O/W) containing the claimed combination of organic UV filters such as, 2-hydroxy-4-methoxybenzophenone-5-sulphonic acid trihydrate, 2,2'-dihydroxy-4,4'-dimethoxybenzophenone-5- sulphonate (col. 3, lines 41-55), inorganic sun blocks such as, zinc oxide, titanium dioxide and the like (col. 3, lines 16-40) and polyglyceryl-4 isostearate



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(Example 1). Billia et al. employs polyglyceryl-4 isostearate in concentration of 1 wt% which is within the claimed range. See Example 1.

Thus, Billia et al. teach each and every limitation of Claims 1, 2 and 5-7.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 6, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. in view of Kaplan (US 5,047,232) or Grollier et al.

Gers-Barlag et al. teach a sunscreen cosmetic composition and a method for achieving or increasing the water resistance of sunscreen formulations as discussed above.

Gers-Barlag et al. fails to teach specific polyglyceryl compounds of Claims 6 and 10. However, Kaplan teaches using polyglyceryl-3 diisostearate as a preferable emulsifier in waterproof sunscreen compositions. See col. 3, line 32.

Furthermore, Grollier et al. teach employing any mono- and diesters of fatty acids (C12-C18) and glycerol or polyglycerol as emulsifiers in sunscreen emulsions. See col. 5, lines 27-39.

Therefore, an ordinary practitioner would have a reasonable expectation of success using any mono- and diesters of fatty acids (C12-C18) and glycerol or polyglycerol as emulsifiers for sunscreen

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compositions in the absence of clear showing of any unexpected results attributable to the applicant's specific selection of polyglyceryl compounds.

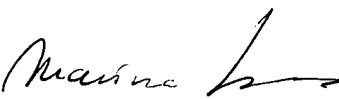
Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

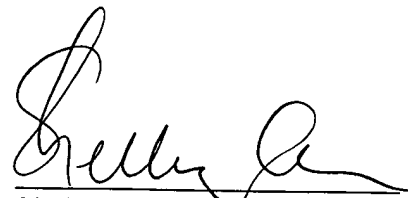
No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml   
November 4, 1998

  
Shelley A. Dodson  
Primary Examiner  
Art Unit 1616